

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Youhei SAKAMOTO et al.

Application No.: 10/573,805

Confirmation No.: 9375

Filed: October 1, 2004 (Int'l)

Art Unit: 2617

For: MOBILE PHONE HAVING A NON-
TELEPHONE FUNCTION AND TIMING
RESET UNIT (As Amended)

Examiner: C. Shedrick

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on March 10, 2010, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying
TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal

VII.	Argument
VIII.	Claims
IX.	Evidence
X.	Related Proceedings
Appendix A	Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Kyocera Corporation

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 11 claims pending in the present application.

B. Current Status of Claims

1. Claims canceled: none
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-11
4. Claims allowed: none
5. Claims rejected: 1-11

C. Claims On Appeal

The claims on appeal are claims 1-11.

IV. STATUS OF AMENDMENTS

No amendments remain outstanding. Applicants did not file an Amendment after the Final Rejection dated December 10, 2009.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a mobile phone having a non-telephone function, which is a different function from a telephone function, in addition to the telephone function. (See Fig. 1 and the corresponding written description). The mobile phone includes a timer operable to count time; a non-telephone unit operable to execute the non-telephone function; a non-telephone function stop unit operable to cause the timer to operate during execution of the non-telephone function, and automatically stop the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period (see paragraphs [0040], [0041], [0073] and [0074] of the present specification); and a telephone unit operable to execute the telephone function. The mobile phone further includes a reset unit operable, if the timer is being operated in response to the execution of the non-telephone function, to reset the timer to an initial state each time a predetermined operation relating to the telephone function is executed.

Independent claim 11 is directed to an automatic stopping method used in a mobile phone having a non-telephone function in addition to a telephone function and used for automatically stopping execution of the non-telephone function. (See Fig. 2 and the corresponding written description). The automatic stopping method includes (a) causing a timer, operable to count time, to operate during the execution of the non-telephone function, and judging, according to the timer, whether a predetermined time period has elapsed; (b) if the timer is being operated in response to the execution of the non-telephone function, resetting the timer to an initial state each time a certain operation relating to the telephone function is executed; and (c) automatically stopping the execution of the non-telephone function when the step (a) determines that the predetermined time period has elapsed (see, *e.g.*, paragraphs [0040], [0041], [0073] and [0074] of the present specification).

According to various embodiments of the present invention, since a reset unit can reset the timer to its initial state each time a predetermined operation relating to the telephone function is executed, the timer starts counting time from the beginning. Accordingly, during a predetermined time counted by the timer, the non-telephone function, which is different from the telephone function, can be executed.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1 and 9 are patentable under 35 U.S.C. §112, first paragraph; whether claims 1-3 and 5-11 are patentable under 35 U.S.C. §103(a) over Tagawa et al. (U.S. Patent No. 6,947,728) (hereinafter “Tagawa”) in view of Nariai et al. (U.S. 2002/0082059) (hereinafter “Nariai”); and whether claim 4 is patentable under 35 U.S.C. §103(a) over Tagawa in view of Nariai, and further in view of Yoshinaga (U.S. Patent No. 7,096,045).

VII. ARGUMENT

Claim 1-11 stand rejected. Applicants request reversal.

A. Rejections of claims 1 and 9 under 35 U.S.C. §112

Claims 1 and 9 stand rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that the term “non-telephone function stop unit” is not *explicitly* labeled in the original disclosure.

The original disclosure, as published as U.S. Pat. Pub. No.: 2007/0121533A1, reads as follows:

[0040] In the case when a setting for enabling the auto power off is stored in the setting storage unit 12, the auto-power-off control unit 16 causes a built-in timer to operate during execution of the FM radio function, and automatically stops the execution of the FM radio function when the built-in timer indicates that a predetermined time period has elapsed.

[0041] Additionally, in order to avoid occurrences of the alarm being inactivated due to battery depletion, even when a setting for disabling the auto power off is stored in the setting storage unit 12, if the setting for enabling the alarm is stored, the auto-power-off control unit 16 causes the built-in timer to operate during the execution of the FM radio function, and automatically stops the execution when the built-in timer indicates that a predetermined time period has elapsed.

[0073] Besides the mobile phone with an FM radio, the present invention is also applicable to a mobile phone having other various non-telephone functions.

[0074] Here, the various non-telephone functions include, for example: a digital camera function; an Internet connecting function; a music play function; a radio function; and a TV function.

Applicants note that, according to MPEP §2163, “[w]hile there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.” (MPEP §2163). However, “[t]he fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. The written description requirement, according to MPEP §2163, is not determined based solely on whether a phrase in the claim is *explicitly* provided in the specification (*i.e.*, *in haec verba*), as the Examiner suggests. Instead, to satisfy the written description requirement, a specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the invention as claimed.

In this case, portions of the present specification provided above clearly show support for a mobile phone, for example, with non-telephone functions (*e.g.*, a digital camera function, an Internet connecting function, a music play function, a radio function, and/or a TV function). Further, the specification discloses an auto-power-off control unit 16 that automatically *stops* the execution of the FM radio function (*i.e.*, a non-telephone function) when the built-in timer indicates that a predetermined time period has elapsed.

Therefore, it would be abundantly clear to one of ordinary skill in the art that the original disclosure provides at least implicit support for the "non-telephone function stop unit" (see at least auto-power-off control unit 16) of claims 1 and 9, by describing a control unit that stops a non-telephone function.

It is submitted that the Examiner misapplies 35 U.S.C. §112, first paragraph, in rejecting independent claims 1 and 9 and, thus, reversal of the rejections is respectfully requested.

B. Rejections of claims 1-3 and 5-11 under 35 U.S.C. §103(a)

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tagawa in view of Nariai. It is submitted, however, that claim 1 is allowable over the cited combination of references. Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has misinterpreted the cited art and the features of independent claim 1.

For convenience, independent claim 1 as previously presented is reproduced below:

1. A mobile phone having a non-telephone function, which is a different function from a telephone function, in addition to the telephone function, comprising:
 - a timer operable to count time;
 - a non-telephone unit operable to execute the non-telephone function;
 - a non-telephone function stop unit operable to cause the timer to operate during execution of the non-telephone function, and automatically stop the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period;
 - a telephone unit operable to execute the telephone function; and
 - a reset unit operable, if the timer is being operated in response to the execution of the non-telephone function, to reset the timer to an initial state each time a predetermined operation relating to the telephone function is executed.

i. The Cited Art Fails to Teach or Suggest a Reset Unit as Recited in Claim 1

According to certain embodiments of the present invention, since the reset unit resets the timer to its initial state each time a predetermined operation relating to the telephone function is executed, the timer counts time from the beginning. Accordingly, during an elapse of a predetermined time counted by the timer, the non-telephone function, which is different from the telephone function, can be executed.

Tagawa describes a control unit 103 which is "operable to count elapsed time after a call arrives" (paragraph 0024) (emphasis added). Tagawa further discusses "a call time during stopping reproducing music data is counted" (paragraph 0099) (emphasis added). Moreover, the control unit 103 "starts counting the time elapsed from the point when the ring tone starts reproducing" (paragraph 0112) (emphasis added).

"The control unit 103 counts the time elapsed from the point when the ring tone starts reproducing, determines whether the communication unit 108 gives notice of starting communication before the said counted elapsed time goes beyond a predetermined time, thereby determining whether or not a user responded to a call within a predetermined time (S811). If the user responded to a call within a predetermined time, the control unit 103 finishes the process. On the other hand, if the user did not respond to a call within a predetermined time, it has the reproduction unit 106 stop reproducing the ring tone assuming that the user has no will to respond to a call (S812), resumes reproduction of music data if the reproduction thereof is stopped, and returns the sound volume of music data to the ordinary volume (in a call waiting mode) if the music data is being reproduced as BGM, so as to complete the processing." (paragraph 0113) (emphasis added).

Accordingly, Tagawa discloses a count of elapsed time after an incoming call arrives.

Tagawa further discloses "the reproduction sound volume of music data v is faded out from v1 to 0 during the time of t1 <=t<=t2 as shown in a full line LA1, and at the same time, the sound volume of the ring tone is faded in from 0 to v3 during the time of t1<=t<=t2 as shown in FIG. 13B." (paragraph 0128)

In this case, according to Tagawa, a timer does not need to be reset, because time-between t1 and t2 can be counted by recording time t1 and time t2 and then calculating t2 – t1.

Furthermore, Tagawa discloses "resuming reproduction at the position rewound for a specified time of seconds from the position of stopping reproduction" (see paragraph 0098); and "in order to run back for a specified value, it is necessary in reproduction to store addresses per second, for example, in a RAM from the beginning of the file and calculate an appropriate address at which reproduction is resumed based thereon." (See paragraph 0100).

Therefore, according to Tagawa, in the case of resuming the reproduction of music data at a point turned back for a predetermined number of seconds from a point where the reproduction is stopped, a timer is unnecessary. As a result, a *reset* of a timer is also unnecessary and does not occur.

Accordingly, the Examiner concedes that Tagawa fails to teach or suggest automatically stopping the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period. Hence, Nariai is newly cited in the final Action as disclosing these features.

Nariai discloses:

[0015] In a first preferred embodiment, the controller performs control so that the reproduction of the data is stopped after a lapse of an arbitrary preset time from the start of the reproduction of the data.

According to this description, a timer is initialized at the start of reproduction of data. After a lapse of a preset time, the reproduction of the data is stopped.

In contrast, according to the reset unit of present claim 1, a timer is reset to an initial state *each time a predetermined operation relating to the telephone function is executed*. That is, not execution of the telephone function, but execution of the *non-telephone function* is stopped after

an elapse of a predetermined time period. Therefore, Nariai at least fails to cure the deficiencies of Tagawa described above.

As a result, it is respectfully submitted that amended independent claim 1 patentably distinguishes over both Tagawa and Nariai, alone or in combination. Independent claim 11 recites features substantially similar to those described above with respect to claim 1. Therefore, it is respectfully submitted that independent claim 11 patentably distinguishes over Tagawa and Nariai for at least the foregoing reasons.

Claims 2-3 and 5-10 depend from independent claim 1 and inherit the patentability thereof. Therefore, the pending dependent claims patentably distinguish over the cited art for at least the reasons presented herein.

C. Rejection of claim 4 under 35 U.S.C. §103(a)

Dependent claim 4 stands rejected as being unpatentable over Tagawa in view of Nariai, and further in view of Yoshinaga. Claim 4 inherits the patentability of independent claim 1, which patentably distinguishes over Tagawa and Nariai for the reasons presented above. Further, Applicants submit that Yoshinaga fails to cure the deficiencies of the cited art described herein.

In fact, Yoshinaga discloses:

"Here, it is assumed that the control section 3 can always grasp a no-operation time of the inputting section 8 by the user while the portable telephone set is in an unfolded state. In particular, the unfolded/folded state detection section 7 always monitors an unfolded/folded state of the portable telephone set and immediately notifies the control section 3 if an unfolding or folding operation is performed. The control section 3 recognizes unfolding or folding of the portable telephone set based on the notification of the unfolded/folded state detection section 7. In this instance, if unfolding of the portable telephone set is recognized, then the control section 3 starts measurement of time from that point of time. Thereafter, if an operation of the user is performed through the inputting section 8, then the measurement time is reset every time and the measurement is re-started from the beginning. The control section 3 forms

time measurement means. Further, the time measurement is performed only while the portable telephone set remains unfolded, but the time measurement function is stopped at the point of time when the portable telephone set is folded." (column 7, lines 35-55).

Yoshinaga further discloses:

"On the other hand, if a call is terminated at the portable telephone set while the body of the portable telephone set is unfolded, then the annunciation method determination section 6 detects no-operation time of the user measured by the control section 3 and discriminates whether or not the elapsed no-operation time is 30 seconds or more (step 204). If the elapsed non-operation time is 30 seconds or more, then the annunciation method determination section 6 determines that the annunciation method B (with the singing, annunciation sound volume 1, annunciation pattern β , and annunciation time of 3 seconds) is used to perform annunciation and gives a reply of the determined contents to the control section 3 (step 205). Then, the control section 3 controls the annunciation section 10 to perform a termination annunciation operation using the annunciation method B (step 207). On the other hand, if the discrimination in step 204 indicates that the elapsed non-operation time is less than 30 seconds, then the annunciation method determination section 6 determines that the annunciation method C (with the vibration or emission of light, and annunciation time of 1 second) is used to perform annunciation and gives a reply of the determined contents to the control section 3 (step 206). Then, the control section 3 similarly controls the annunciation section 10 to perform termination annunciation operation using the annunciation method C (step 207)." (column 8, lines 31-55).

Thus, according to Yoshinaga, what is measured and reset is the *no-operation time* of the user. The no-operation time is used merely for notification and not for stopping a function.

Therefore, it is respectfully submitted that Yoshinaga fails to disclose the aforementioned features of independent claim 1, and is not cited as doing such. Accordingly, independent claim 1, as well as dependent claim 4, patentably distinguishes over any combination of references cited by the Examiner.

D. Conclusion

For the forgoing reasons, Applicants respectfully request reversal of the Examiner's rejections of claims 1-11.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Applicant on July 30, 2009.

IX. EVIDENCE

None.

X. RELATED PROCEEDINGS

None.

Dated: May 10, 2010

Respectfully submitted,

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APPENDIX A**Claims Involved in the Appeal of Application Serial No. 10/573,805**

1. A mobile phone having a non-telephone function, which is a different function from a telephone function, in addition to the telephone function, comprising:
 - a timer operable to count time;
 - a non-telephone unit operable to execute the non-telephone function;
 - a non-telephone function stop unit operable to cause the timer to operate during execution of the non-telephone function, and automatically stop the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period;
 - a telephone unit operable to execute the telephone function; and
 - a reset unit operable, if the timer is being operated in response to the execution of the non-telephone function, to reset the timer to an initial state each time a predetermined operation relating to the telephone function is executed.
2. The mobile phone of Claim 1, wherein
the reset unit resets the timer to the initial state at end of a telephone call.
3. The mobile phone of Claim 2, wherein
the telephone unit stops executing the telephone function when receiving a disconnect signal via a telephone line at the end of the telephone call, and
the reset unit resets the timer to the initial state when the execution of the telephone function is stopped by receiving the disconnect signal.
4. The mobile phone of Claim 1, wherein
the reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed.

5. The mobile phone of Claim 1, wherein
the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the non-telephone unit is started.
6. The mobile phone of Claim 1, further comprising:
an application unit operable to execute an application different from the non-telephone function and the telephone function, wherein
the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the application unit is started.
7. The mobile phone of Claim 1, wherein
the reset unit resets the timer to the initial state each time a particular key is pressed by a user.
8. The mobile phone of Claim 1, further comprising:
an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein
the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made.
9. The mobile phone of Claim 1, further comprising:
an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein
the non-telephone function stop unit automatically stops the execution of the non-telephone function in a case when
 - (i) an auto-power-off setting has been made by the user, or
 - (ii) the alarm setting has been made by the user although the auto-power-off setting has not been made.

10. The mobile phone of Claim 1, wherein

the non-telephone function is any of a digital camera function, an Internet connecting function, a music play function, a radio function, and a TV function.

11. An automatic stopping method used in a mobile phone having a non-telephone function in addition to a telephone function and used for automatically stopping execution of the non-telephone function, the automatic stopping method comprising the steps of:

(a) causing a timer, operable to count time, to operate during the execution of the non-telephone function, and judging, according to the timer, whether a predetermined time period has elapsed;

(b) if the timer is being operated in response to the execution of the non-telephone function, resetting the timer to an initial state each time a certain operation relating to the telephone function is executed; and

(c) automatically stopping the execution of the non-telephone function when the step (a) determines that the predetermined time period has elapsed.